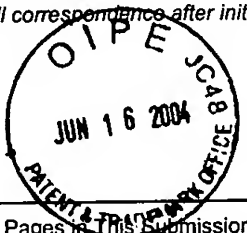


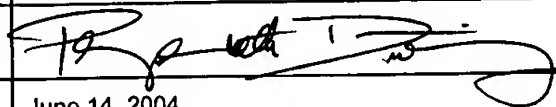
Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1>TRANSMITTAL FORM</h1> <p>(to be used for all correspondence after initial filing)</p> 		Application Number	09/311,674
		Filing Date	May 13, 1998
		In re Application of:	Penina KATZ
		Group Art Unit	3623
		Examiner Name	Meinecke Diaz, S.
		Attorney Docket Number	09710-1183
Total Number of Pages in This Submission	84	Client Docket Number	WMA96015 AA

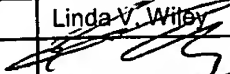
RECEIVED
JUN 21 2004
GROUP 5600

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request of Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Additional Enclosure(s) (please identify below):
Remarks: Filed with one month extension		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	DITTHAVONG & CARLSON, P.C.		
	Phouphanomketh Dithavong, Reg. No. 44658		
Signature			
Date	June 14, 2004		

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, VA 22313-1450 on this date: 6/14/04			
Type or printed name	Linda V. Wiley		
Signature		Date	June 14, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL

for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant Claims small entity status. See 37 CFR 1.01.

TOTAL AMOUNT OF PAYMENT (\$ 440.00)

Complete if Known

Application Number 09/311,674

Filing Date May 13, 1998

First Named Inventor Katz

Examiner Name Meinecke Diaz, S.

Art Unit 3623

Attorney Docket No. 09710-1183

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account

Deposit Account Number

13-2491

Deposit Account Name

MCI, Inc.

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee

to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0.00)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20**=	X	
Multiple Dependent	-3**=	X	

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$ 0.00)

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053		Non-English specification	
1812	2,520	1812		For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804		Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805		Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	110.00
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451		Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	840	2503	320	Plant issue fee	
1460	130	1460		Petitions to the Commissioner	
1807	50	1807		Processing fee under 37 CFR 1.17(q)	
1806	180	1806		Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802		Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 440.00)

SUBMITTED BY

Name (Print/Type)

Phouphanomketh Dithavong

Registration No.
(Attorney/Agent)

44658

Complete (if applicable)

Telephone

(703) 425-8508

Signature

Date

June 14, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 37 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

09/311,674



Patent

AF/3623
120

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Penina KATZ

Application No.: 09/311,674

Group Art Unit: 3623

Filed: May 13, 1998

Examiner: Meinecke D.

Attorney Docket: 09710-1183

Client Docket: WMA96015 AA

For: TELEPHONE BASED PERSONNEL TRACKING SYSTEM

APPEAL BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

RECEIVED
JUN 21 2004
GROUP 3600

This Appeal Brief is submitted, in triplicate, in support of the Notice of Appeal dated March 10, 2004.

I. REAL PARTY IN INTEREST

MCI, Inc., is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF THE CLAIMS

Claims 1-29 are pending in this appeal, in which claims 30-32 have earlier been canceled, and the appeal of claims 30-32 is hereby withdrawn. No claim is allowed. This appeal is therefore taken from the final rejection of claims 1-29 on December 10, 2003.

IV. STATUS OF AMENDMENTS

The amendment to claim 29 filed February 10, 2004 has been entered.

V. SUMMARY OF THE INVENTION

The present invention addresses problems associated with tracking the location and/or arrival and departure times of employees. The disclosed and claimed invention is directed to placement of telephone calls to a computer system for tracking such employees. The computer system detects data that indicates the origin of the telephone calls from calling telephones located at various sites, and receives, from the calling telephones, identification data. Calling employees can enter information such as individual access codes and other codes that designate whether they have arrived or are departing from a work site. (Specification, page 9, lines 25 – 31) The identification information, for example Automatic Number Identification (ANI), is verified against reference data contained in a reference data base 40 (FIG. 2) to screen or reject unauthorized telephone calls. (Specification, page 13, lines 24 – 28) Upon verifying that the correct ANI and identification (ID) information have been received, a computer record is generated of the call. This record is stamped with a time and date indicia and preferably with further indicia which indicate (in response to an appropriate entry made by the field employee) whether the record pertains to an arrival or departure of the employee from the particular work site. (Specification, page 14, line 32 – page 15, line 6)

VI. ISSUES

A. Whether claims 1-6, 8-13, 15-22, and 24-29 are anticipated under 35 U.S.C § 102 by *Oliver* (US 4,839,917).

B. Whether claims 1-29 are obvious under 35 U.S.C. § 103 based on *Hedges* (US 3,819,862).

VII. GROUPING OF CLAIMS

The claims should not be regarded as all standing together since the claims recite respective limitations that render each of the claims separately patentable. For the purposes of this appeal, the following groups are recognized:

1. Claims 1-4, and 29: claim 1 is representative;
2. Claim 5;
3. Claim 6;
4. Claim 7;
5. Claim 8;
6. Claims 9 and 15: claim 9 is representative;
7. Claim 10;
8. Claim 11;
9. Claim 12;
10. Claim 13;
11. Claim 14;
12. Claim 16;
13. Claims 17-20, and 28: claim 17 is representative;

- 14. Claim 21;
- 15. Claim 22;
- 16. Claim 23;
- 17. Claim 24;
- 18. Claim 25;
- 19. Claim 26; and
- 20. Claim 27.

VIII. ARGUMENT

A. THE EXAMINER'S LEGAL BURDEN

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

A prior art reference anticipates a patent claims if it discloses every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). “Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999).

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 148 USPQ 721 (CCPA 1966); *In re Freed*, 165 USPQ 570 (CCPA 1970). The Examiner is required to show that all the claim limitations are taught or suggested by the references. *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 165 USPQ 494 (CCPA 1970).

Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Gartside*, 203 F.3d 1305,

1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). In particular, the Patent Office must articulate and place on the record the “common knowledge” used to negate patentability. *In re Zurko, id.*; *In re Sang Su Lee*, No. 00-1158 (Fed. Cir., Jan. 18, 2002).

B. CLAIMS 1-6, 8-13, 15-22, AND 24-32 ARE NOT ANTICIPATED BY OLIVER, BECAUSE OLIVER FAILS TO DISCLOSE “ENABLING SAID COMPUTER TO VERIFY SAID IDENTIFICATION DATA AGAINST REFERENCE DATA STORED IN A REFERENCE DATA BASE.”

Claim 1 recites (*Emphasis Added*):

“enabling said computer to **verify said identification data** against reference data stored in a reference data base.”

The Examiner contends that this feature is met by *Oliver* (Final Office Action, page 6).

At col. 13: 3-18 (cited by the Examiner), *Oliver* states:

Employing this option, each employee with duties in the area served by the system may be assigned a personal identification number (PIN). It typically is a number unused for extensions. Any time the employee dials his PIN from any substation set served by this system, his location is recorded at the monitor station as well as the time of day. This is done by this system without intervention of the central office switch or PBX switchboard.

In its normal use, covered personnel merely dial in their PIN number of the nearest telephone set at any time and their location is recorded at the monitor station.

Appellant maintains that neither the above cited passage nor anywhere else within *Oliver* is there a disclosure of verifying the PIN, and thus the feature of “enabling said computer to **verify said identification data** against reference data stored in a reference data base” cannot be met. In fact, *Oliver* is absolutely silent with respect to the terms “verify” or “verification.”

Nevertheless, without any factual basis within the four corners of *Oliver*, the Examiner, per the Final Office Action (Page 2, line 22 – Page 3, line 16) draws the conclusion that “in order for a personal identification number (PIN) to serve as identification of the person entering a PIN,

there must be an understood correlation between the PIN and the person to whom the PIN is assigned (i.e., ideally the person entering the PIN into the system) The fact that Oliver's PIN numbers are stored in a computer is indicative of the verification of a person's identification against reference data (i.e., PIN data) stored in a reference data base (i.e., a collection of data stored on the computer)." This conclusory analysis effectively ignores the subject claim language altogether.

The claimed invention includes a feature to "verify said identification data," in part, to screen or reject unauthorized telephone calls, as pointed out in the Section V. SUMMARY OF THE INVENTION. By contrast, the *Oliver* system fails to contemplate any manner to explicitly verify the PIN; at best as understood, use of such PIN is itself sufficient for operation.

Appellant notes that the anticipatory rejection of the claims is neither properly Officially Noticed nor properly Based Upon Common Knowledge. MPEP § 2144.03, 37 CFR § 1.111(b), *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). The Examiner does not explicitly mention "Official Notice" or "Common Knowledge," but instead states, "It was well **understood** to one of ordinary skill in the art at the time of Applicant's invention that, once a person enters a PIN, the PIN is matched to an entry in a database (i.e., any collection of data) in order to find the identification corresponding to the entered PIN," and asserts that certain statements of *Oliver* are "indicative of" the claimed features. The Examiner provides no legal basis whatsoever for any origin of the stated features.

To the extent that the Examiner is relying on "common knowledge," Appellant respectfully submits the Examiner's rejection is thus improper, in contravention of MPEP § 2144.03 (E), which states:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art **without documentary evidence to support the examiner's**

conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

Furthermore, the Examiner overlooks a fundamental feature: the claims recite the placement of “telephone calls.” The *Oliver* system, however, operates not by placement of “telephone calls” in the context of the claims. *Oliver* discloses that an employee dials his PIN from any substation set, and that “This is done by this system **without intervention of the central office switch or PBX switchboard.**” (col. 13: 12-13; see also col. 2: 39-59) It is clear dialing of a PIN without intervention of the central office switch or the PBX switchboard cannot be equated to a “telephone call,” in the manner claimed. Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); MPEP § 2111.01. “Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999). In the present case, one of ordinary skill in the art would not understand a “telephone call” to be dialing digits in a telephone set without intervention of a switching facility to place the call to be a “telephone call.”

Accordingly, the rejection of claims 1-6, 8-13, 15-22, and 24-32 in view of *Oliver* is improper and should be reversed by the Honorable Board.

C. CLAIMS 5, 6, 10-13, 21 AND 22 ARE NOT ANTICIPATED BY *OLIVER*, BECAUSE *OLIVER* FAILS TO DISCLOSE USE OF EITHER “AUTOMATIC NUMBER IDENTIFICATION (ANI)” OR “CALLER-ID.”

Claims 5, 12, and 21 recite the following features:

“wherein said data that indicates the origin of telephone calls is based on Automatic Number Identification (ANI).”

Claim 10 recites the following features:

“wherein said information associated with valid sites is based on ANI.”

Claims 6, 13, and 22 recite the following features:

“wherein said data that indicates the origin of telephone calls is based on Caller-ID.”

Claim 11 recites the following features:

“wherein said information associated with valid sites is based on Caller-ID.”

With respect to the above features, the Examiner offers the terse explanation (Final Office Action, page 6, item 5) that “Oliver teaches using PBX system to automatically detect the call’s origin and location. Therefore, Oliver teaches the equivalent of ANI and caller ID systems at the time of the invention and therefore is considered to be inherent in Oliver to use any equivalent device to obtain the same result.”

The Examiner misapplies the law of inherency, and appears to further confuse the rejection with reliance on the doctrine of equivalents, which has no relevance in the rejection of the claims. At the outset, the Examiner undermines her argument by stating that *Oliver* teaches an “equivalent” of ANI and Caller ID, which is contrary to the notion that the missing features of

ANI and caller ID are in fact inherent. That is, ANI and caller ID would not be inherent in *Oliver*, as the *Oliver* system is presumably performing the substitutable function already. Inherency requires the descriptive matter that is not explicit in the reference to be nonetheless necessarily present; based on the Examiner's own analysis, this cannot be the case as the *Oliver* system's "equivalent" functions eliminate the necessity of the claimed features.

As explained in Section VIII (B), the *Oliver* system operates without intervention of the central office switch or PBX switchboard cannot possibly accommodate the use of ANI and Caller ID, which are switch-based features.

Furthermore, the Examiner erroneously generalizes the specific features of "ANI" and "Caller ID" to be broad principles. These features are in fact specific telephony protocols and services, not a general concept, which underlies the Examiner's faulty premise. *Oliver* is devoid of any mention of ANI and Caller ID.

Accordingly, the rejection of claims 5, 6, 10-13, 21 and 22 in view of *Oliver* is improper and should be reversed by the Honorable Board.

D. CLAIMS 8, 16 AND 24 ARE NOT ANTICIPATED BY OLIVER, BECAUSE OLIVER FAILS TO DISCLOSE "RECEIVING FROM THE CALLING TELEPHONES COMPUTER COMPATIBLE FUNCTION CODES INDICATIVE OF WHETHER SAID EMPLOYEE HAS ARRIVED OR IS DEPARTING FROM A WORK SITE."

Claims 8, 16, and 24 recite the following features (*Emphasis Added*):

"receiving from the calling telephones computer compatible function codes indicative of whether said employee has arrived or is departing from a work site."

As regard these features, the Examiner ignores the claim language; understandably, as *Oliver* provides no support for the rejection of these claims. The above claimed “codes” cannot be interpreted as the PIN, which the Examiner construes as the claimed “identification data,” as both features are distinct elements in the claims. Moreover, the use of a PIN by the *Oliver* system does not convey “whether said employee has arrived or is departing from a work site,” and thus cannot reasonably be construed as the claimed “codes.”

By failing to address these claim features, the Examiner has left the Appellant to rely on conjecture for the reasoning of her rejection. This is in direct contravention of 35 U.S.C. § 132, which requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to respond.” Unfortunately, the Examiner has provided no rationale for her rejection with respect to the features of “receiving from the calling telephones computer compatible function **codes indicative of whether said employee has arrived or is departing from a work site,**” leaving Appellant without a fair opportunity to respond.

Accordingly, Appellant contends that the rejection is improper and should be reversed by the Honorable Board.

- E. **CLAIMS 9-16, 25 AND 27 ARE NOT ANTICIPATED BY *OLIVER*, BECAUSE *OLIVER* FAILS TO DISCLOSE “ENABLING SAID COMPUTER TO COMPARE THE INDICATED ORIGIN OF EACH OF SAID TELEPHONE CALLS WITH INFORMATION ASSOCIATED WITH VALID WORK SITES THAT IS STORED IN A REFERENCE DATA BASE.”**
-

Claim 9 recites the following features (*Emphasis Added*):

“enabling said computer to **compare the indicated origin of each of said telephone calls with information associated with valid work sites** that is stored in a reference data base.”

The Examiner continues the pattern of ignoring the claim features, this time by failing to address “information associated with **valid work sites**.” *Oliver* is completely silent on this feature. Thus, Appellant is left to guess at the rejection, again in contravention of 35 U.S.C. § 132.

Accordingly, Appellant contends that the rejection is improper and should be reversed by the Honorable Board.

- F. **CLAIMS 17-24, AND 26 ARE NOT ANTICIPATED BY *OLIVER*, BECAUSE *OLIVER* FAILS TO DISCLOSE “ENABLING SAID COMPUTER TO COMPARE THE INDICATED ORIGIN OF EACH OF SAID TELEPHONE CALLS WITH INFORMATION ASSOCIATED WITH SAID IDENTIFICATION DATA.”**
-

Claims 17, 24, and 26 recite the following features:

“enabling said computer to compare the indicated origin of each of said telephone calls with information associated with said identification data.”

By contrast, *Oliver* discloses no such comparison. From what Appellant can understand based on the brief explanation of the rejection (Final Office Action, page 6, item 5), the Examiner

equates the PIN as the identification data. However, the *Oliver* system never discloses comparing the PIN with any information, much less with “origin of each of said telephone calls.”

Accordingly, Appellant contends that the rejection is improper and should be reversed by the Honorable Board.

G. CLAIMS 1-29 ARE NOT OBVIOUS OVER HEDGES.

Claim 1 recites the following features (*Emphasis Added*):

“enabling said computer to detect data that indicates the origin of **telephone calls** received by said computer from calling telephones located at various sites ...
enabling said computer to **verify said identification data** against reference data stored in a reference data base.”

In contrast, *Hedges* merely discloses a system for indicating the condition of hotel rooms, whereby a portable unit is carried by a maid or other personnel and is adapted to a communication channel. The portable unit identifies the room and the particular portable unit. (Abstract; col. 6: 15-20) The *Hedges* system provides no capability to verify or compare as claimed, and is completely silent on the use of a reference data base. *Hedges*, at col. 2: 15-22, states that an “object” of its invention is to provide a system which includes “an interface circuit for connecting the unit in a room to the telephone line for applying signals thereto which **do not interfere with the normal use of the telephone lines.**” Fig. 1 of *Hedges* shows, emanating from the PBX 27, an “outside line,” a “long distance” line, and a “data coupler 29” which is shown coupled to the computer 10. (see col. 2: 43-46) At col. 5: 12-16, *Hedges* states, “The information to be applied to the telephone lines can be provided by audio frequency signals having characteristics such that **they will not interfere with other signals present on the**

telephone lines.” Thus, *Hedges* is merely using telephone lines or other communication channels to enable the portable unit to communicate signals with the computer, and is not using “telephone calls” to communicate with the computer, and the signals do not interfere with the normal use of the telephone lines. Again, one of ordinary skill in the art would not interpret *Hedges*’ use of telephone lines as the claimed “telephone calls.”

Claim 17 recites (*Emphasis Added*):

“telephone calls received by said computer from calling telephones at various sites ... a computer readable program code means for enabling said computer to **compare the indicated origin of each of said telephone calls with information associated with said identification data.**”

In stark contrast, the operation of the *Hedges* system revolves around the use of the portable unit, which provides identification of the room and the person. (Col. 5: 40-43) This disclosure, however, falls short of providing “telephone calls” made to a computer system, or of “origin of each of said telephone calls,” much less comparing “the indicated origin of each of said telephone calls with information associated with said identification data.” This point is made more evident below with respect to claim features of “ANI” and “Caller ID,” as found in dependent claims 5, 6, 10-13, 21, and 22.

As regards dependent claims 5, 6, 10-13, 21, and 22, the Examiner acknowledges (Final Office Action, page 8) that *Hedges* fails to disclose the use of ANI or caller ID, but nevertheless contends that “*Hedges* teaches that a device is used to transmit an ID of the telephone set to the computer, the telephone ID being associated with a particular room.” The Examiner further asserts that “This is the same principle on which ANI and caller ID is based,” thereby concluding that “one with ordinary skill in the art would have been motivated to use a well known, more

modern technology at the time of the invention to perform the same functionality as taught by Hedges.”

Appellant first notes that the portable unit of the *Hedges* system does not in fact identify the telephone set, but the portable unit itself and the room (col. 5: 40-43; col. 6: 13-20). Additionally, as discussed above, the portable unit does not make a “telephone call” to the computer system. Therefore, the extrapolation of the functions of the portable unit to ANI and caller ID is technically without merit.

Secondly, Applicant notes that ANI and caller ID are network based services, and are associated with “telephone calls;” thus, the modification that the Examiner is suggesting to *Hedges* is no mere use of modern technology, in that the *Hedges* system provides no suggestion on identifying the room using network services or “telephone calls,” merely contemplating providing such function with the portable unit. Therefore, the Examiner’s contention (Final Office Action, page 5) that “ANI and caller ID technology indeed exemplify mere uses of analogous modern technology, especially in light of the fact that Hedges was filed in 1972 – eighteen years before Applicant’s earliest priority date of 1990” is in error.

In apparent acknowledgement of the many deficiencies of *Hedges*, the Examiner resorts to no less than five mentions of “notoriously old and well known” (pages 7 and 8 of the Final Office Actions). This can hardly be deemed a showing of substantial evidence, as required by the Administrative Procedures Act (APA).

The Examiner’s attempt at expediency in dismissing the claims results in technically unsupportable constructions. For instance, claims 7, 14, and 23 recite (*Emphasis Added*):

“wherein said data that indicates the origin of telephone calls is based on a **cellular location.**”

The Examiner makes the following assertion (Final Office Action, page 8) in finding a motivation to modify the *Hedges* system to accommodate the claimed feature of “cellular location”:

Hedges does teach using alternative communicating devices, such as the television cable, to communicate with the central computer. Cellular phones are modern versions of land-based telephones with the same features but wireless.

Appellant agrees that *Hedges* discloses (per the Abstract) “the communication channel may be the telephone **lines** which provide telephone services to the rooms, a television antenna **cable**, or any other communication channel, or any other communication channel which is available.” *Hedges* describes wired communication solutions as possible alternatives to the telephone lines. The Examiner makes the quantum leap that cellular phones are modern versions of land-based telephones, “but wireless.” Even if *Hedges*, *arguendo*, intimates that a wireless solution can be used, one of ordinary skill in the art would not use a cellular system as the wireless solution. The *Hedges* system seeks to operate within a hotel scenario, and thus, employing a cellular system would be technically infeasible and, at best, cost prohibitive.

Accordingly, the obviousness rejection of claims 1-29 over *Hedges* is improper and should be reversed by the Honorable Board.

IX. CONCLUSION AND PRAYER FOR RELIEF

The applied references of *Oliver* and *Hedges* fail to teach the various claim features. The Examiner has unreasonably construed the claimed invention, completely inconsistent with the supporting Specification, or the art of record. Also, the Examiner has rejected the several claims in a manner that contravenes 35 U.S.C. § 132. Further, the heavy reliance on Official Notice does

not alleviate the Examiner's burden to provide a showing of substantial evidence in establishing a *prima facie* case of obviousness.

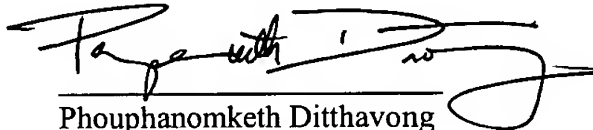
Appellant, therefore, requests the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 13-2491, and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG & CARLSON, P.C.

6/4/04
Date


Phouphanomketh Ditthavong
Attorney for Applicant(s)
Reg. No. 44658

10507 Braddock Rd, Suite A
Fairfax, VA 22032
Tel. 703-425-8516
Fax. 703-425-8518

APPENDIX

1. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones located at various sites;

a computer readable program code means for enabling said computer to receive, from the calling telephones, identification data associated with employee tracking;

a computer readable program code means for enabling said computer to verify said identification data against reference data stored in a reference data base;

a computer readable program code means for enabling said computer to create telephone call records based on some of said telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records.

2. (Original) The computer software product of claim 1, wherein said identification data is comprised of at least one employee identification datum and each said employee identification datum of said identification data respectively indicates at least one employee.

3. (Original) The computer software product of claim 1, wherein said identification data indicates a work site.

4. (Original) The computer software product of claim 1, wherein said report is based on said data that indicates the origin of telephone calls.

5. (Original) The computer software product of claim 1, wherein said data that indicates the origin of telephone calls is based on Automatic Number Identification (ANI).

6. (Previously Presented) The computer software product of claim 1, wherein said data that indicates the origin of telephone calls is based on Caller-ID.

7. (Previously Presented) The computer software product of claim 1, wherein said data that indicates the origin of telephone calls is based on a cellular location.

8. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones located at various sites;

a computer readable program code means for enabling said computer to receive, from the calling telephones, identification data, wherein said identification data indicates an employee;

a computer readable program code means for enabling said computer to verify said identification data against reference data stored in a reference data base;

a computer readable program code means for receiving from the calling telephones computer compatible function codes indicative of whether said employee has arrived or is departing from a work site;

a computer readable program code means for enabling said computer to create telephone call records based on some of said telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records and information indicative of the arrival and departure time of said employee at said work site.

9. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones at various work sites;

a computer readable program code means for enabling said computer to receive, from the calling telephones, identification data associated with employee tracking;

a computer readable program code means for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base;

a computer readable program code means for enabling said computer to create telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records.

10. (Original) The computer software product of claim 9, wherein said information associated with valid sites is based on ANI.

11. (Previously Presented) The computer software product of claim 9, wherein said information associated with valid sites is based on Caller-ID.

12. (Original) The computer software product of claim 9, wherein said data that indicates the origin of telephone calls is based on ANI.

13. (Previously Presented) The computer software product of claim 9, wherein said data that indicates the origin of telephone calls is based on Caller-ID.

14. (Original) The computer software product of claim 9, wherein said data that indicates the origin of telephone calls is based on a cellular location.

15. (Original) The computer software product of claim 9, wherein said report is based on said data that indicates the origin of telephone calls.

16. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones at various work sites;

a computer readable program code means for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base;

a computer readable program code means for receiving from the calling telephones computer compatible function codes indicative of whether an employee has arrived or is departing from a work site;

a computer readable program code means for enabling said computer to create telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records and information indicative of the arrival and departure time of said employee at said work site.

17. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones at various sites;

a computer readable program code means for enabling said computer to receive, from each of said calling telephones, identification data associated with employee tracking;

a computer readable program code means for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with said identification data;

a computer readable program code means for enabling said computer to create telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records.

18. (Original) The computer software product of claim 17, wherein said identification data is comprised of at least one employee identification datum, and each said employee identification datum of said identification data respectively indicates at least one employee and said information associated with said identification data is based on a work site.

19. (Original) The computer software product of claim 17, wherein said identification data indicates a work site.

20. (Original) The computer software product of claim 17, wherein said report is based on said data that indicates the origin of telephone calls.

21. (Original) The computer software product of claim 17, wherein said data that indicates the origin of telephone calls is based on Automatic Number Identification (ANI).

22. (Previously Presented) The computer software product of claim 17, wherein said data that indicates the origin of telephone calls is based on Caller-ID.

23. (Original) The computer software product of claim 17, wherein said data that indicates the origin of telephone calls is based on a cellular location.

24. (Previously Presented) A computer software product comprising a computer usable medium having computer readable program code means embodied in said medium for causing an applications program to execute on a computer, said computer readable program code means comprising:

a computer readable program code means for enabling said computer to detect data that indicates the origin of telephone calls received by said computer from calling telephones at various sites;

a computer readable program code means for enabling said computer to receive, from each of said calling telephones, identification data, wherein said identification data indicates an employee;

a computer readable program code means for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with said identification data;

a computer readable program code means for receiving from the calling telephones computer compatible function codes indicative of whether said employee has arrived or is departing from a work site;

a computer readable program code means for enabling said computer to create telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

a computer readable program code means for enabling said computer to generate a report containing information contained in some of said telephone call records and information indicative of the arrival and departure time of said employee at said work site.

25. (Previously Presented) A method of tracking employees and generating employee reports, the method comprising:

receiving telephone calls by a computer system from calling telephones located at various work sites;

detecting data that indicates the origin of said telephone calls;

receiving from the calling telephones identification data associated with employee tracking;

comparing the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base;

creating telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

generating a report containing information contained in some of said telephone call records.

26. (Previously Presented) A method of tracking employees and generating employee reports, the method comprising:

receiving telephone calls by a computer system from calling telephones located at various sites;

detecting data that indicates the origin of said telephone calls;

receiving from each of said calling telephones identification data associated with employee tracking;

comparing the indicated origin of each of said telephone calls with information associated with said identification data;

creating telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

generating a report containing information contained in some of said telephone call records.

27. (Previously Presented) A system for tracking employees and generating employee reports, comprising:

a computer system;

means for coupling the computer system to a telephone network;

means for receiving telephone calls by said computer system from calling telephones located at various work sites;

means for detecting data that indicates the origin of said telephone calls;

means for receiving from the calling telephones identification data associated with employee tracking;

means for comparing the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base;

means for creating telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

means for generating a report containing information contained in some of said telephone call records.

28. (Previously Presented) A system for tracking employees and generating employee reports, comprising:

a computer system;

means for coupling the computer system to a telephone network;

means for receiving telephone calls by said computer system from calling telephones located at various sites;

means for detecting data that indicates the origin of said telephone calls;

means for receiving from each of said calling telephones identification data associated with employee tracking;

means for comparing the indicated origin of each of said telephone calls with information associated with said identification data;

means for creating telephone call records based on some of said received telephone calls and stamping each of said telephone call records with a time; and

means for generating a report containing information contained in some of said telephone call records.

29. (Previously Presented) A method of tracking employees and generating employee reports, the method comprising:

placing telephone calls to a computer system from calling telephones located at various work sites, wherein said computer system detects data that indicates the origin of said telephone calls, creates telephone call records based on some of said telephone calls and stamps each of said telephone call records with a time;

entering at the calling telephones employee identification data associated with employee tracking that is verified by said computer system against reference data stored in a reference data base; and

receiving a report containing information contained in some of said telephone records.

30. - 32. (Canceled)